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In re Application of
DECKMAN et al.
Application No.: 08/545,707
PCT No.: PCT/EP94/01301
Filing Date: 25 April 1994
Priority Date: 23 April 1993
Attorney Docket No.: A017
For: MOLECULAR SIEVE LAYERS AND
PROCESSES FOR THEIR MANUFACTURE

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: DECISION ON PETITION
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This is a decision on applicants' "PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)" filed in the Patent and Trademark Office (PTO) on 15 June 1999. The required petition fee of \$1210.00 (37 CFR 1.17(m)) has been charged to Deposit Account No. 05-1712.

BACKGROUND

On 25 April 1994, applicant filed international application PCT/EP94/01301 which claimed a priority date of 23 April 1993 and which designated the United States.

On 06 March 1998, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) or (b) and the surcharge for submitting an oath or declaration later than 30 months from the priority date must be filed. The notification set a one-month time limit in which to respond.

On 14 September 1998, applicant filed the following papers: a petition and fee for a five-month extension of time; the surcharge for submitting the declaration later than 30 months from the priority date; a declaration executed by eight of the eleven inventors; and a petition and fee for the petition under 37 CFR 1.47(a).

In a decision dated 11 May 1999, the PTO informed the applicant that the application was **ABANDONED** as of midnight 08 September 1998.

On 15 June 1999, applicant filed the present petition seeking revival under 37 CFR 1.137(b) with the appropriate fee.

DISCUSSION

A. Petition under 37 CFR 1.137(b)

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

With regard to Item (1), the proper response was the declaration filed on 08 September 1998 and 28 September 1998. Pursuant to 37 CFR 1.42, first sentence, "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent." A review of the declaration filed 14 September 1998 reveals that Jannetje Maatje Van Den Berge has executed the declaration as executrix of the Estate of Johannes P. Verduijn. The declaration is acceptable under 37 CFR 1.42 and complies with 37 CFR 1.497(a)-(b). Accordingly, the requirements for entry into national stage under 35 U.S.C. 371(c) were completed as of 14 September 1998.

As to Item (2), the appropriate petition fee of \$1210.00 as required by 37 CFR 1.17(m) was submitted.

With regard to Item (3), applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

As to Item (4), the terminal disclaimer filed by the applicant is not acceptable. Pursuant to 37 CFR 1.137(c), "any terminal disclaimer pursuant to this paragraph must also apply to any patent granted on any continuing application that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the application for which revival is sought. The terminal disclaimer provided by the applicant states that "[t]his terminal disclaimer applies to any patent granted on the above-identified application or any application which entitled to the benefit of the filing date of this application under 35 U.S.C. 120." Applicant has not included specific references under 35 U.S.C. 121 or 365. Therefore, applicant has not satisfied Item (4).

B. Proof of Authority under 37 CFR 1.44

Section 409.01(b), Proof of Authority of Administrator or Executor, of the Manual of Patent Examining Procedure (M.P.E.P.) states, in part:

"In the case of foreign executors or administrators, a consular officer of the United States or a notary public from a member country to the Hague Convention Abolishing the Requirement of Legislation for Foreign Public Documents must authenticate the signature of the foreign officer attesting to the papers submitted as proof of authority. If documents are authenticated by a notary public in a member country, an apostille must be used. See MPEP § 602.04."

When an inventor is deceased, proof of authority of the legal representative should take the form of a certificate of a court of competent jurisdiction (an English translation thereof, if necessary) naming the person or persons having the legal authority to act on behalf of the deceased joint inventor. The certificate must have the signature of the official signing the document authenticated by a consular officer of the United States or be accompanied by an appropriate apostille. See MPEP 409 - 409.01(f) and 602.04.

The papers submitted on 21 September 1999 are not sufficient to establish the authority of Jannetje Maatje Van Den Berge, because the papers submitted are not court certificates, but rather documents signed by a notary and an appropriate apostille has not been provided.

CONCLUSION

For the reasons above, the petition is DISMISSED without prejudice.

The application remains ABANDONED with regards to national stage processing in the United States.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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